



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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11/11/93 SCHWARTZ

E6M1/0420

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EXAMINER	
MANCUSO, J	
ART UNIT	PAPER NUMBER
	9

2013
DATE MAILED: 01/20/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 1/18/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 12 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-11 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.65 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1835 C.D. 11; 453 O.G. 213.
14. ☐ Other

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5, 8-10 drawn to an apparatus for determining the location, size and orientation of probes, classified in Class 382, subclass 48.

II. Claims 6, 7, drawn to a system for determining the location of a scrub mark on an object, such as an IC or wafer, classified in Class 382, subclass 6.

2. III. Claim 11, drawn to a method for sanding probe tips, classified in Class 324, subclass 158P.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as can be used for determining the location of any object (not only probes) within the view of an imaging system. Group II has separate utility such as determining the presence of any material or mark on an object. See M.P.E.P. § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have a separate status in the art as shown by their different classifications and the search for each group is

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substantially different, restriction for examination purposes as indicated is proper.

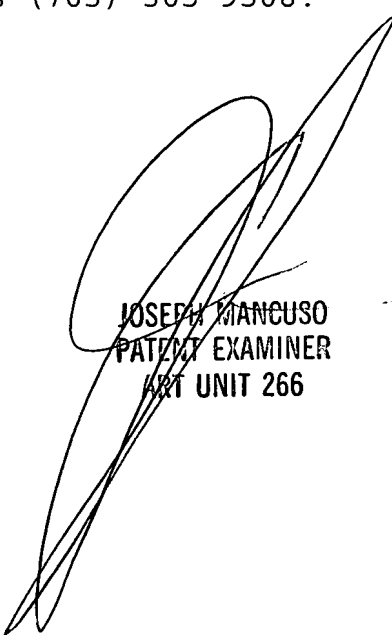
5. It is noted that in paragraph 2 of paper number 5 the examiner indicated that because of the poor form of the originally filed claims a proper determination of the possibility of restriction was not possible at the time of the first examination, though it did appear that a restriction may have been possible. With the amended claims now presented, it is clear that restriction is proper. Further, it is noted that if applicant elects group III, which contains claim 11, the specification still appears to not be enabling for this claim.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Mancuso whose telephone number is (703) 305-4927.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

The Group 2600 Fax number is (703)-305-9508.

jm
April 17, 1995



JOSEPH MANCUSO
PATENT EXAMINER
ART UNIT 266